

REMARKS

The Office Action mailed November 8, 2006 has been carefully considered. Within the Office Action Claims 38-55 and 57-59 have been rejected. The Applicant has amended Claims 38 and 55. Reconsideration in view of the above amendments and following remarks is respectfully requested.

Rejection under 35 U.S.C. § 103

Claims 38, 39, 42, 47, 48, 55, 58, and 59 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Murphy (US 4,667,182) (hereinafter “Murphy”) in view of U.S. Van Ketwich (US 6,072,475) (hereinafter “Ketwich”). The Applicant respectfully traverses.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

M.P.E.P. 2141, See Hodosh v. Block Drug Co., Inc., 786 F.2d 1136 (Fed. Cir. 1986) (When applying a 35 U.S.C. 103 rejection, the following tenets of patent law must be adhered to: the claimed invention must be considered as a whole; the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; the references must be viewed without the benefit of impermissible hindsight vision afforded by the

claimed invention; and reasonable expectation of success is the standard with which obviousness is determined.)

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fed. Cir. 1983). Thus, when considering the whole prior art reference its entirety, portions that would lead away from the claimed invention must be considered. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983) (emphasis added), See M.P.E.P. 2141.02. Thus, it is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731 (Fed. Cir. 1983).

Murphy describes a stylus for interactive use with a graphics input tablet which provides a user with a tactile response whenever the stylus tip passes through the in-presence boundary of the tablet. The “in-presence boundary” is defined in Murphy as the distance in the air vertically above the tablet surface beyond which the position signals of the stylus are regarded as unreliable, because the tablet cannot accurately read those signals. Murphy specifically states that it is desirable to give the user an indication of whether the stylus is ‘in-presence’ (which is where the stylus is between ‘in-presence’ boundary and the tablet) or ‘out of presence’ (which is where the stylus is above and beyond the ‘in-presence’ boundary) and thus whether or not the workstation is tracking the stylus tip.

However, there is no hint, teaching or suggestion in Murphy that the actuator applies a haptic sensation in response to the sensor signal indicating the stylus at a coordinated position on the surface, wherein the haptic sensation is applied while the stylus is in contact with the surface as recited in Claims 38 and 55. Instead, Murphy describes applying a tactile response when the

tip passes through an imaginary in-presence boundary not on the surface, but at some point above the surface of the tablet.

Claim 38 recites, among other things, an actuator disposed within the stylus and configured to apply a haptic sensation in response to the at least one sensor signal indicating the stylus at a designated coordinate position on the surface, wherein the actuator applies the haptic sensation while the stylus is in contact with the surface. Claim 55 recites, among other things, applying a force from an actuator to the stylus in response to the coordinate position signal indicating the stylus being at a designated location on the surface, wherein the haptic sensation is applied while the stylus is in contact with the surface. Murphy combined with Ketwich do not teach each and every limitation and element in Claims 38 and 55 as required to establish a *prima facie* case for obviousness. See Hodosh. Accordingly, Claims 38 and 55 are patentable over Murphy and Ketwich, individually or in combination. Therefore, Claims 38 and 55 are in a condition for allowance.

Regarding Claim 49, the Office Action rejects Claim 49 as allegedly obvious over in view of Ketwich. The Applicant respectfully traverses.

The Applicant is perplexed as to why the Examiner has again rejected Claim 49 over the Taniishi reference, especially after Applicant's arguments clearly distinguished Taniishi from the claimed subject matter (as referenced by the withdrawal of the rejection citing Taniishi). Taniishi discloses a vibration transmitting plate 8 which is placed over a display, whereby a vibrating input pen 3 transmits vibrations therefrom via the plate 8 to three vibration sensors 6 positioned at corner portions of the plate 8. The vibration sensors 6 then measure the transmission times of the ultrasonic vibrations transmitted from the vibrating input pen 3 to determine the coordinates of the vibrating input pen 3 on the plate 8.

One skilled in the art would have absolutely no motivation to use Taniishi, let alone use Taniishi with Ketwich to reach the subject matter recited in Claim 49. Claim 49 recites, among other things, a sensor in communication with a host computer, the sensor configured to detect a coordinate position of the stylus against a surface and provide a coordinate position signal associated with the coordinate position of the stylus only while the stylus is moved along the surface; and an actuator coupled to the stylus, the actuator configured to vibrate in response to the sensor detecting the coordinate position of the stylus and the coordinate position signal indicating the stylus is positioned at a designated location on the surface (emphasis added). As stated above, Taniishi describes that the vibration sensor are able to determine the coordinates of the stylus from the vibration of the stylus, not the other way around, as recited in Claim 49. Therefore, Taniishi teaches away from the subject matter recited in Claim 49 and would thus cannot be considered by one skilled in the art. See Grasselli. Accordingly, Claim 49 is allowable over Taniishi in view of Ketwich.

Regarding Claims 40, 41, 44, 45 and 48, these claims are dependent on Claim 38; Claims 50, 51 and 53 are dependent on Claim 49; and Claims 57 is dependent on Claim 55. Claims 38, 49 and 55 are allowable over the cited prior art, individually or in combination for at least the reasons stated above. Accordingly, Claims 40, 41, 44, 45, 48, 50, 51, 53 and 57 are allowable as being dependent on allowable base claims.

Conclusion

It is believed that the present application is in condition for allowance and early favorable consideration of this reply is earnestly solicited. If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Please charge any additional required fee or credit any overpayment not otherwise paid or
credited to our deposit account No. 50-1698.

Respectfully submitted,

Dated: 2/8/07


S. Bhattacharya
Suvashis Bhattacharya
Reg. No. 46,554

THELEN REID BROWN RAYSMAN & STEINER LLP
P.O. Box 640640
San Jose, CA 95164-0640
Tel. (408) 292-5800
Fax. (408) 287-8040